

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter that applicants regard as the invention.

Claims 1-27 remain in this application.

The examiner objected to figure 1 for not having descriptive legends. The figure has been amended to add descriptive legends, without adding any new matter, making the objection moot.

The examiner's objections to claims 11, 20, and 27 are moot because those claims have been amended as suggested by the Examiner to correct errors in the claim language and for clarification purposes.

Claims 1, 4, 7, 13-15, 21/15, 23/15, 23/15, 26 and 27 were rejected under 35 U.S.C. §102(b) as being anticipated by Brillhart *et al.* (U.S. 5,303,306). The remaining claims were rejected under 35 U.S.C. §103(a) as being unpatentable over Brillhart in view of various other references. For the following reasons, the rejections are respectfully traversed.

Claim 1, as amended, recites a step of "automatically adjusting parameters of a parameter set saved in the hearing device and belonging to the identified momentary surround situation with the aid of an input unit operated by the hearing device user in accordance with the hearing desire of the hearing device user" and also a step of "manually adjusting parameters of said parameter set further in accordance with the hearing desire of the hearing device user".

Claim 15, as amended, recites a hearing device system where "parameters of the adjusted parameter sets resulting from the momentary transmission characteristics of the transmission unit are automatically adjustable according to the hearing desire of the hearing device user with the aid of the input unit" and where "said parameters are further manually adjustable according to the hearing desire of the hearing device user".

Claim 26, as amended, recites an “input unit” comprising “input means to generate information for an automatic and a manual adjustment of parameters of a parameter set of a hearing device”.

None of the references teach any automatic adjustment of parameters, as recited in the above claims, and none recite the ability to adjust parameters both automatically and manually, as also recited in the claims. At most, Brillhart, as cited by the Examiner, might teach that a transfer function of a hearing device can be manually adjusted by remote control. However, there is no teaching of automatic adjustment of the transfer function, and there is no teaching of both automatic and manual adjustment.

Accordingly, claims 1, 15, and 26 are patentable over the references. The remaining claims, which depend, directly or indirectly, upon one of claims 1, 15, and 26, are thus patentable over the references for at least the same reasons as the parent claims.

Further, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the desirability of the combination (*Id.*). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner provides generalized insufficient motivations, such as arguing that the modifications are for the “convenience of the user” or for providing “advantages”, which are clearly not legally sufficient motivation to support a prima facie case of obviousness. Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found

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in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious “as a whole”, not as a piecemeal combination of elements from various references.

Accordingly, the rejections for obviousness are not supported by the Office action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 35469US1.

Respectfully submitted,
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Amendments to the Drawings:

The attached drawing sheet includes changes to Fig. 1. This sheet, which includes Fig. 1, replaces the original sheet including Fig. 1. In Figure 1, previously omitted descriptive legends have been added.

Attachment: Replacement Sheet.